

REMARKS

The amendment does not involve new matter. The first paragraph of the specification has been updated to include the patented status of the parent application. This overcomes the objection raised in paragraph 1 of the outstanding Office Action. Claims 24 and 26 have been amended to put them in better form, but not for any reason related to patentability.

In the outstanding Office Action, claims 6, 11, 24-27, 30 and 31 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. According to the outstanding Office Action, there is no support in the original disclosure for the concept of mixing an additional high-potency sweetener with the N-substituted aspartame derivative before it is applied in the rolling compound or in the coating. This rejection is respectfully traversed. First, claims 24-27, 30 and 31 do not include the limitation that is asserted as not being taught in the original disclosure. Second, under the section "SUMMERY OF INVENTION," where different aspects of the invention are discussed, page 4 lines 7-11 states: "The high-potency N-substituted derivative of aspartame sweetener may also be combined with other high-potency sweeteners including, but not limited to, thaumatin, aspartame, acesulfame K, sodium saccharin, sucralose, alitame, cyclamate, stevioside, glycyrrhizin and dihydrochalcones." From the context of these lines in the Summery Of Invention, it is clear that this statement refers to all of the different ways that N-substituted derivatives of aspartame are suggested for use in chewing gum, including in a coating and in a rolling compound.

In the outstanding Office Action, claims 6, 11, 24-27, 30 and 31 were also rejected under 35 U.S.C. § 112, second paragraph, as the claims failed to recite a positive method step of "applying." Claims 24 and 26 have been amended to recite that the N-substituted derivative of aspartame "is applied". It is believed that this recitation now provides the positive method step requested.

Claims 6, 11, 24-27, 30 and 31 were rejected in the outstanding Office Action under 35 U.S.C. §103(a) as unpatentable over U. S. Patent No. 5,480,668 (Nofre) in view of U.S. Patent No. 4,997,659 (Yatka). This rejection is also respectfully traversed.

Claims 6, 24-25 and 30 require using a N-substituted derivative of aspartame as part of a rolling compound on a chewing gum product. Claims 11, 26-27 and 31 require using an N-substituted derivative of aspartame as part of a coating on a chewing gum pellet. Nofre makes no suggestion for using the disclosed sweeteners in such a fashion. While Yatka discloses using alitame as a part of a rolling compound and in a pellet coating, there is no suggestion in Yatka to use other sweeteners in this fashion. There is no reason from the references themselves to combine the references and treat N-substituted derivatives of aspartame the way alitame was treated. This rejection is thus based on hindsight.

Just because one high-potency sweetener was used in a particular fashion in producing chewing gum does not mean that it would have been obvious to use other high-potency sweeteners in the same fashion. Moreover, alitame was suggested for use in these ways in Yatka because of a desire to delay its release or separate it from other ingredients which may cause the alitame to degrade. The need for delayed release or prevention of degradation has not been shown in the prior art as being applicable to N-substituted derivatives of aspartame. Rather, Nofre shows the stability of the N-substituted derivatives of aspartame disclosed therein when used in chewing gum (see Col. 3, lines 51-60); and there is no suggestion that the materials release too quickly from chewing gum.

The Office Action notes that Nofre teaches to mix an N-substituted derivative of aspartame with alitame and then add that mixture into chewing gum. The Office Action then goes on to argue that it would have been obvious to use this mixture in place of the pure alitame in the way that Yatka teaches to use the alitame by itself. This argument is also based on hindsight. The most that a person of ordinary skill in the art would learn from Nofre is to add the mixture to edible products, not even chewing gum specifically. Again, there is no teaching in Nofre to use the mixture in other ways, or to use it in place of alitame in all other ways that alitame is used. Nor is there anything in Yatka that teaches to use combinations of sweeteners in place of alitame. There is nothing in Yatka that would suggest treating a combination of alitame and an N-substituted derivative of aspartame the same way that alitame was used, and nothing in Nofre that would suggest looking at Yatka for ideas about how to include mixtures of alitame and

an N-substituted derivative of aspartame in chewing gum products. While Yotka teaches to use alitame in a chewing gum coating or in a rolling compound, it does not suggest that any other high-potency sweetener should be mixed with the alitame and used in the same way. The simple fact of the matter is that the combination suggested by the Office Action in making the rejection would not have been made without hindsight of the present invention.

Claims 6, 11, 24-27, 30 and 31 were rejected in the outstanding Office Action under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,692,778. Without acquiescing in the correctness of that rejection, a terminal disclaimer over the '778 patent is submitted herewith to overcome this rejection.

Since each of the reasons for the rejections have been overcome, it is believed that the case is in condition for allowance. An early notice of allowance is therefore respectfully requested.

Respectfully submitted,

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